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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
DESAI, ANISH P	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/712,943	WORKMAN, GARY	
	Examiner	Art Unit	
	Anish Desai	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *November 13th 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *02/13/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelch et al (US Patent 5,695,870).

2. Regarding Claims 1 and 2, Kelch et al. disclose a laminated foam board made of expanded polystyrene (Column 4, limes 31-32). The foam board is laminated with a thermoplastic film (Column 2, lines 52-55). Note that regarding Claim 1, the recitation that "An unbonded capping system for strength testing of concrete masonry units" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951). Additionally, please note regarding the claim 1 that the examiner is not giving patentable weight to the recitation "to be received on a face of a concrete masonry unit", "being engagable by a test apparatus, in use" and "engaging the face of the concrete masonry unit to provide even load distribution during testing". It has been held that a recitation with respect to manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPq2d 1647 (1987).

3. Regarding claims 3,4 and 6, the expanded polystyrene foam board disclosed in the invention of Kelch et al. has density from about 10 kg/m^3 to about 70 kg/m^3 (Column

6, lines 27-30). The said density of the polystyrene foam in the English units equates to about 0.62 lb/ft^3 to 4.4 lb/ft^3. The plastic film is laminated to the foam board using adhesive (Column 3, lines 49-52).

4. Claims 7-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelch et al. (US Patent 5,695,870).

5. The invention of Kelch et al. is disclosed above.

6. Note that with regards to claim 7, the recitation that "For use with a testing system for compression testing of concrete masonry units including first and second platens, a pair of compression pads each comprising" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951). Additionally, please note regarding the claim 7 that the examiner is not giving patentable weight to the recitation "to be received on a face of a concrete masonry unit", "being engagable by a test apparatus, in use" and "engaging the face of the concrete masonry unit to provide even load distribution during testing". It has been held that a recitation with respect to manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPq2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hadley et al. (US Patent 3,545,263) in view of Kelch et al. (Us Patent 5,695, 870).

8. Hadley et al. disclose a compression testing machine (see Title). The machine designed for testing concrete blocks by compression (Column 1, lines 50-53). The machine includes a lower platen and an upper platen. A test piece is placed between the said platens (Column 1, lines 53-59).

9. Hadley et al. are silent with respect to teaching that a plastic sheet laminated to an expanded polystyrene foam board using adhesive. Moreover, Hadley et al. are silent with respect to teaching that the rigid foam board comprises expanded polystyrene foam board with density of 2 lb/ft^3 and 3 lb/ft^3, thickness of the foam board to be 0.5 inches and the thickness of the plastic sheet to be about 0.06 inches. Thus one in the possession of the invention of Hadley et al. would have to look elsewhere.

1. Kelch et al. disclose a laminated foam insulation board having enhanced strength and resistance to bending and breaking (See Abstract). According to Kelch et al. relatively thin foam boards used in the insulations are susceptible to physical damaged from bending, impact or breaking (Column 1, lines 22-26). Thus, in order to overcome

the problem of physical damage, facing material should be applied to at least one side of the foam board to strengthen it (Column 1, lines 33-35). The facing material can be a plastic film (Column 1, lines 37-40). The foam board disclosed in the invention of Kelch et al. can be either extruded polystyrene board or expanded polystyrene bead foam (Column 4, lines 31-33). The density of the polystyrene foam board is preferably from about 10 kg/m^3 to about 70 kg/m^3 (Column 6, lines 27-30). The said density of the polystyrene foam in the English units equates to about 0.62 lb/ft^3 to 4.4 lb/ft^3. The thickness of the polystyrene foam board is about 0.24 in to about 1 in (Column 4, lines 40-44). Kelch et al. disclose that the face film maybe laminated to the foam board by any conventional method known in the art (e.g. adhesive) (Column 3, lines 49-52). The thickness of the facer film (i.e. the plastic film) is from about 0.35 mils to about 11 mils (Column 3, lines 44-46). The thickness of the said facer film in the English units equates to $3.5 * 10^{-4}$ in to 0.01 in.

2. Regarding Claims 1 and 2, the inventions of Hadley and Kelch et al. are disclosed above.

3. A skilled artisan would have found it obvious to use expanded polystyrene foam laminated with plastic film disclosed in the invention of Kelch et al. and used it in the invention of Hadley et al. One would be motivated to do this in order to provide a laminated foam board that has enhanced strength and resistance to breaking, so that it can effectively prevent the movement of concrete specimen under compressive loading.

4. Regarding, claims 3 and 4, the inventions of Hadley and Kelch et al. are disclosed above.

5. A skilled artisan would have found it obvious to use polystyrene foam board with the density disclosed in the invention of Kelch et al and used it in the invention of Hadley et al. One would be motivated do this in order to provide a foam board with higher strength.

6. Regarding claim 5, the inventions of Hadley and Kelch et al. are disclosed above.

7. A skilled artisan would have found it obvious to use an expanded polystyrene foam board of thickness disclosed in the invention of Kelch et al. and used it in the invention of Hadley. One would be motivated to do this because such a laminated foam board will provide effective strength and will not break when it is received on a face of a concrete specimen undergoing compressive testing.

8. Although the invention of Hadley et al. in view of Kelch et al. does disclose the claimed invention except for the thickness of the plastic sheet to be about 0.06 in. It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the thickness of the plastic sheet of about 0.06 in, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

9. Regarding Claim 6, the inventions of Hadley et al. and Kelch et al are disclosed above.

10. A skilled artisan would have found it obvious to use adhesive to bond a plastic film to an expanded polystyrene foam board disclosed in the invention of Kelch et al. and used it in the invention of Hadley et al. One would be motivated to do this in order to provide a laminated plastic board that has enhance strength.

11. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hadley et al. (US Patent 3,545,263) in view of Nelson (US Patent 4,740,025) and further in view of Kelch et al. (Us Patent 5,695, 870).

12. The inventions of Hadley and Kelch et al. are disclosed above. Hadley is silent with respect to teaching a pair of pads.

13. Nelson discloses an improved compound gripper device useful with laboratory glassware and suitable with low or high gripping forces (See Abstract). The device comprises a pair of gripping pads made of resilient organic resins such as polyurethanes (Column 2, lines 61-64). One of the objects of the invention of Nelson is to provide gripping pads which can maintain its gripping efficiency.

14. Nelson is silent with respect to teaching that the expanded polystyrene foam board has density greater than 2 lb/ft^3 or about 3 lb/ft^3 and that the foam board has thickness of about 0.5 inches. Additionally, Nelson is silent with respect to teaching that a plastic sheet is adhesively laminated onto the foam board and the thickness of the plastic sheet is about 0.06 in.

15. Regarding claim 7 and 8, the inventions of Hadley et al., Nelson and Kelch et al. are disclosed above.

16. A skilled artisan would have found it obvious to use an expanded polystyrene foam laminated with plastic film disclosed in the invention of Kelch et al. and used it in the invention of Hadley et al. as compression pads. One would be motivated to do this

in order to provide a laminated foam board that has enhanced strength and resistance to breaking, so that it can effectively prevent the movement of concrete specimen under compressive loading.

17. Regarding claims 9 and 10, the inventions of Hadley et al., Nelson and Kelch et al. are disclosed above.

18. A skilled artisan would have found it obvious to use an expanded polystyrene foam board with the density disclosed in the invention of Kelch et al and used it in the invention of Hadley et al. One would be motivated do this in order to provide a foam board with higher strength.

19. Regarding claim 11, the inventions of Hadley et al., Nelson and Kelch et al. are disclosed above.

20. A skilled artisan would have found it obvious to use an expanded polystyrene foam board of thickness disclosed in the invention of Kelch et al. and used it in the invention of Hadley. One would be motivated to do this because such a laminated foam board will provide effective strength and will not break when it is received on a face of a concrete specimen undergoing compressive testing.

21. Although the invention of Hadley et al. in view of Kelch et al. does disclose the claimed invention except for the thickness of the plastic sheet to be about 0.06 in. It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the thickness of the plastic sheet of about 0.06 in, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

22. Regarding claim 12, the inventions of Hadley et al., Nelson and Kelch et al. are disclosed above.

23. A skilled artisan would have found it obvious to use adhesive in bonding the plastic film to the an expanded polystyrene foam board disclosed in the invention of Kelch et al. and used it in the invention of Hadley et al. One would be motivated to do this in order to provide a laminated plastic board that has enhance strength.

24. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hadley et al. (US Patent 3,545,263) in view of Nelson (US Patent 4,740,025) and further in view of Kelch et al. (Us Patent 5,695, 870).

25. The inventions of Hadley et al., Nelson and Kelch et al. are disclosed above.

26. Regarding claims 13 and 14, a skilled artisan would have found it obvious to use an expanded polystyrene foam board laminated with a plastic film disclosed in the invention of Kelch et al. and used it in the invention of Hadley et al. One would be motivated to do this in order to provide a laminated foam board that has enhanced strength and resistance to breaking, so that it can effectively prevent the movement of concrete specimen under compressive loading.

27. Regarding, claims 15 and 16, the inventions of Hadley et al., Nelson and Kelch et al. are disclosed above.

28. A skilled artisan would have found it obvious to use an expanded polystyrene foam board with the density disclosed in the invention of Kelch et al and used it in the invention of Hadley et al. One would be motivated do this in order to provide a foam board with higher strength.

29. Regarding claim 17, a skilled artisan would have found it obvious to use an expanded polystyrene foam board of thickness disclosed in the invention of Kelch et al. and used it in the invention of Hadley. One would be motivated to do this because such a laminated foam board will provide effective strength and will not break when it is received on a face of a concrete specimen undergoing compressive testing.

30. Although the invention of Hadley et al. in view of Kelch et al. does disclose the claimed invention except for the thickness of the plastic sheet to be about 0.06 in. It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the thickness of the plastic sheet of about 0.06 in, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

31. Regarding claim 18, A skilled artisan would have found it obvious to use adhesive to bond the plastic film to an expanded polyurethane foam board disclosed in the invention of Kelch et al. and used it in the invention of Hadley et al. One would be motivated to do this in order to provide a laminated plastic board that has enhance strength.

32. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hadley et al. (US Patent 3,545,263) in view of Nelson (US Patent 4,740,025) and further in view of Kelch et al. (Us Patent 5,695, 870).

33. The inventions of Hadley et al., Nelson and Kelch et al. are disclosed above.

34. Regarding claim 19, a skilled artisan would have found it obvious to use an expanded polystyrene foam board laminated with a plastic film disclosed in the invention of Kelch et al. and used it in the invention of Hadley et al. One would be motivated to do this in order to provide a laminated foam board that has enhanced strength and resistance to breaking, so that it can effectively prevent the movement of concrete specimen under compressive loading.

35. Regarding claim 20, a skilled artisan would have found it obvious to use polystyrene foam board with the density disclosed in the invention of Kelch et al and used it in the invention of Hadley et al. One would be motivated do this in order to provide a foam board with higher strength.

36. Regarding claim 21, a skilled artisan would have found it obvious to use a polystyrene foam board of thickness disclosed in the invention of Kelch et al. and used it in the invention of Hadley. One would be motivated to do this because such a laminated foam board will provide effective strength and will not break when it is received on a face of a concrete specimen undergoing compressive testing.

37. Although the invention of Hadley et al. in view of Kelch et al. does disclose the claimed invention except for the thickness of the plastic sheet to be about 0.06 in. It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the thickness of the plastic sheet of about 0.06 in, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

apd

ELIZABETH M. COLE
PRIMARY EXAMINER